

U.S. Patent Application No. 10/735,295

REMARKS

Claims 1-22 are pending. Claims 15-22 have been canceled. By this amendment, claims 1-14 are pending. No new matter will be incorporated into the present application by entry of this Amendment. If the Office determines that any additional fees are deemed to be necessary with the filing of this Amendment, then the Office is authorized and requested to charge such fees to Deposit Account No. 061910.

Applicant maintains that the original claims are patentably distinct over the cited references. The present Amendment, however, is being filed to focus the pending claims on embodiments that may be separately commercialized, separately licensed, or both. Insofar as the original claims are concerned, Applicant expressly reserves the right to pursue those original claims, or other claims not reciting the features of the present claims, in further prosecution.

In the Office Action of November 11, 2007, the Examiner rejected claims 1-14 under 103(a) as being unpatentable over U.S. Patent No. 4,235,048 to Gillery ("Gillery") in view of U.S. Patent Application Publication No. 2002/0045073 to Finley ("Finley"). Taking into consideration the above submitted amendments, Applicant respectfully requests reconsideration.

Applicant submits that the limitations of the originally offered claims, as well as the claims including the above amendments, sufficiently positively limit the claims to embodiments taught away from by the art. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant. *In re Gurley*, 27 F.3d 551, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994).

Gillery teaches a double glazed window providing different functions depending upon the orientation of the window. Gillery does not disclose or suggest a double glazed window providing two coated surfaces that provide the same function depending upon the orientation of the window. Applicant provides a photocatalytic coating on each side of a reversible window for the purpose of providing the same function to each side. A person of ordinary skill would be discouraged from following Gillery to provide the same photocatalytic function to different sides of a substrate because Gillery emphasizes the use of a reversible window to enhance different functional coatings only. One of ordinary skill reading Gillery would deem the application of the same coating, for the same purpose to both sides of a reversible pane redundant and unnecessary.

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Moreover, contrary to Examiner's suggestion, providing photocatalytic layers on both sides of a window assembly would not be an obvious design choice to one of ordinary skill in the art. Examiner characterizes such a combination as a "mere duplication of parts." However, one of ordinary skill in the art would not obviously apply a photocatalytic coating to both sides of a substrate for at least two reasons. First, a photocatalytic coating on both sides of a substrate may be viewed by a person of ordinary skill in the art as producing a possible decrease in the visible transmittance of the substrate, thereby having an adverse impact on the overall optical properties of the substrate. Second, such a design choice would render one coating, (the interior coating) generally nonfunctional because the interior coating would not receive the direct sun light required to activate the photocatalytic coating. Hence, it is not an "obvious design choice" for one of skill in the art to merely duplicate a photocatalytic coating on both sides of a substrate. To the contrary, it would be obvious for one of ordinary skill in the art to not apply a photocatalytic coating to both sides of a substrate. Therefore, the suggestion of "mere duplication of parts" is not persuasive support for the existence in the art of the limitation of the claims requiring both substrate surfaces to bear a photocatalytic coating.

In view of the foregoing amendments and remarks, it is submitted that all the claims of the application are in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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*Please grant any extension of time necessary for entry, charge any fee due to Deposit Account No. 66-1970*

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March 10, 2008  
Date

  
Jolene R. Krueger

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